

REMARKS

Claim 20 is added, and therefore claims 1 to 20 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

(It is noted that a Response is also being filed in co-pending U.S. Pat. App. Ser. No. 11,698,650 (attorney docket 10191/3107A), which is a continuation application of the present case.)

Applicants note that an Examiner Initiated Interview was conducted on January 4, 2007 with Aaron C. Deditch (reg. no. 33,865). The Examiner suggested amending claims to incorporate the subject matter of claims 5 and 17, the prior rejection of which was not sustained on appeal. Applicants thank the Examiner for her kind suggestion.

It is noted that the Interview Summary form that was used by the Examiner was PTOL-413. However, since this was an Examiner initiated interview, it is respectfully submitted that PTOL-413B should have been used, since the Examiner provided a written summary of the substance of the interview in the non-final Office Action. If Applicant had initiated the Interview (which was not the case), then PTOL-413 would have been the proper form to use. The foregoing procedures are documented and explained in the M.P.E.P. At 713.04 (pages 700-182 to 700-186).

Since, however, the Examiner sent form PTOL-413, it is believed that this response satisfies the request for Applicant to file a Statement of the Substance of the Interview (see pages 700-184 and 700-185 of the M.P.E.P.).

As explained above, the Examiner Interview Summary essentially corresponds to the above summary.

It is believed that this response satisfies the request for Applicant to file a Statement of the Substance of the Interview (see MPEP § 713.04).

Claims 1 to 8, 9, 10, 12, and 14 to 16, 18, and 19 were rejected under 35 USC § 102(e) as anticipated by Yokota et al., U.S. Patent No. 6,463,372. (The summary of the rejections in the Office Action does not reflect the detailed rejections, which are correctly stated and summarized here).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the Board of Appeal’s Decision mailed November 27, 2006 may not be agreed with as to the proper construction of the term impact sensor, claim 1 has been rewritten to clarify specifically that the “at least one non-pedestrian-impact sensor” includes an “acceleration sensor and determines a parameter corresponding to an actual physical force resulting from an object that actually and physically contacts the vehicle”.

Accordingly, it is respectfully submitted that claim 1, as presented, and its dependent claims are allowable over the references of record as applied, since this feature (which is supported by the present application, including as to the embodiments disclosed therein) plainly obviates the concerns of the Board which were based on an overbroad construction of the term phrase “impact sensor”, and since this feature is not identically disclosed or suggested by the Yakota reference, as understood by the Board.

Accordingly, claim 1, as presented, is allowable, as are its dependent claims 2 to 19.

Claim 11 was rejected under 35 U.S.C. § 103(a) as unpatentable over Yokota et al., U.S. Patent No. 6,463,372, in view of Mattes et al. U.S. Patent No. 6,487,482.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 11 depends from claim 1, as presented, and is therefore allowable for essentially the same reasons, since the secondary reference does not cure – and is not asserted to cure – the critical deficiencies of the primary Yokota reference.

Claims 5, 13, and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yokota et al., U.S. Patent No. 6,463,372.

Claims 5, 13 and 17 depend from claim 1, as presented, and are therefore allowable for essentially the same reasons explained above as to claim 1, as presented. It is therefore respectfully requested the obviousness rejections be withdrawn.

New claim 20 does not add any new matter and is supported by the present application. Claim 20 is allowable since the features of claims 5 and 17 are combined with original claim 1, and the Examiner has kindly suggested in the Interview that the combination of claims 1, 5 and 17 would be allowable.

In sum, claims 1 to 20 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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